UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/047,449	01/14/2002	Alois Johannes G. Aarts	05032-00014	1074

22910 7590 10/28/2004

BANNER & WITCOFF, LTD.
28 STATE STREET
28th FLOOR
BOSTON, MA 02109-9601

EXAMINER	
MANLOVE, SHALIE A	

ART UNIT	PAPER NUMBER
1755	

DATE MAILED: 10/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/047,449	AARTS ET AL.
	Examiner	Art Unit
	Shalie A. Manlove	1755

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10 August 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-15* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,5,6,9-14* is/are rejected.

7)☒ Claim(s) *2-4,7 and 8* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Withdrawn Rejections

1. The 35 U.S.C. 101 rejection of record has been withdrawn due to applicant's amendment.

2. The 35 U.S.C. 112 rejections of claims 2-4 and 6 have been withdrawn due to applicant's amendment.

Rejections Repeated

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Murray et al US 3,660,131.

Murray teaches satin white and the process of making by reacting aqueous solutions of calcium hydroxide and aluminum sulfate at a reaction temperature of about 25 to about 43 degrees C and stirring with a blender or kneading for an hour to produce satin white as to instant claims 1 and 14 and (col. 1, lines 54-58; col. 2, lines 8-19). As to the apparatus limitation, the examiner does not see how the recitation of the apparatus changes the composition in any way and thus little to no patentable weight has been given.

4. Claim 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Reynolds et al US 3,494,731.

Reynolds teaches satin white pigment and process of making wherein the pigment produced is of a uniform particle size and in the near colloidal range of 0.05- 0.5, eg., 0.1-0.2 microns (col. 4, lines 34-40).

Claim 6 is a product by process claim, which is a product claim not a process claim.

"[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

5. Claims 1,5, 6, 9, 12, 14and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Stiles et al US 3,563,700.

Stiles teaches a process for making satin white comprising aluminum sulfate, calcium hydroxide and casein or gum Arabic (col. 3, lines 20-40 col. 8, lines 16-20). Stiles disclose reaction time of 30 minutes and an optimum temperature range of 60-75 degrees F (col. 5, lines 40-57 and col. 7, lines 70-75).

With respect to the apparatus limitation of claim 1, unless they affect the process in a manipulative sense, it may have little weight in process claims. *In re Tarczy-Hornoch* 158 USPQ 141, 150 (CCPA 1968); *In re Edwards* 128 USPQ 387 (CCPA 1961); Stalego v.

Heymes 120 USPQ 473, 478 (CCPA 1959) EX PARTE HART 117 USPQ 193 (POBDPATAPP 1957); *IN RE FREEMAN* 44 USPQ 116 (CCPA 1940); *IN RE SWEENEY* 72 USPQ 501 CCPA 1947).

Claim 6 is a product by process claim, which is a product claim not a process claim.

"[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stiles et al US 3,563,700.

Stiles teaches aluminum sulfate and calcium hydroxide reacting for between 12.5 to 30 minutes depending upon the percent solids content, which overlaps the claimed range of between 15 and 25 minutes.

A prima facie case of obviousness typically exists when the range of a claimed composition overlaps the ranges disclosed in the prior art. *In re Malagari*, 499 F.2d 1297, 1303, 182 USPQ 549, 553 (CCPA 1974).

9. Claims 5, and 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murray et al US 3,660,131 in view of Reynolds US 3,494,731.

Murray teaches the invention as described above. Murray does not teach a dispersant. Reynolds teaches in examples 2-6 the dispersant Tamol 850 (sulfonated naphthalene-formaldehyde) is added in an amount of 3-4 % by weight with respect to claims 5,12, and 13. Additionally, wherein the taught dispersant used, the limitation of claim 11 is taught as well.

It would be obvious to one of ordinary skill in the art to recognize that both Murray and Reynolds teach a satin white coating pigment and it would be obvious to introduce a dispersant to Murray in order to enhance or improve the pigment by adding modifiers to improve the behavior of the coating color as that taught by Reynolds.

Allowable Subject Matter

10. Claims 2-4, 7 and 8 are objected to as being referred to a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

11. The following is a statement of reasons for the indication of allowable subject matter: The prior art of record fails to teach or suggest the matter as claimed.

Response to Arguments

12. The remaining arguments have been fully reconsidered but they are not persuasive.

14. Applicant argues that Stiles fails to teach the element of claim 1.

There is no showing that the use of planetary kneader mixer affects the making of the pigment differently from the fast moving vortex, which is a type of high shear mixer. In the absence of convincing objective evidence to the contrary, it would be obvious to use any mixer suitable for the process of making the satin white pigment.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shalie A. Manlove whose telephone number is (571) 272-1372. The examiner can normally be reached on M-TH 6:30-4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark L. Bell can be reached on (571) 272-1362. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Shalie A. Manlove
Examiner
Art Unit 1755

October 25, 2004

C. MELISSA KOSLOW
PRIMARY EXAMINER